

REMARKS

By the present amendment, claims 1 and 10 have been amended by incorporating therein the subject matter of claims 5 and 17, and claims 8-9 have been amended to be dependent on claim 1. Accordingly, claims 5, 12, and 15-20 have been canceled. Also, the two clauses of claim 1 introduced by "wherein" have been presented as separate paragraphs.

It is submitted that the amendment does not raise any new issues, and thus, entry and consideration of the amendment is respectfully requested.

Claims 1-4, 6-11, and 13-14 are pending in the present application. Claims 1 and 10 are the only independent claims.

In the Office Action, claims 1-10 and 12-20 are rejected under 35 U.S.C. 103(a) as obvious over US 5,543,948 to Takahashi et al. ("Takahashi") in view of JP 05-086211 to Matsui et al. ("Matsui JP'211"), and claim 11 is rejected under 35 U.S.C. 103(a) as obvious over Takahashi in view of Matsui and further in view of US 5,725,960 to Konishi et al. ("Konishi").

It is alleged in this Office Action that the claim language does not exclude a primer layer, and that US 5,310,439 to Matsui et al. ("Matsui US'439") shows the use of a primer to increase adhesion between an adhesive and a norbornene film.

Reconsideration and withdrawal of the rejection is respectfully requested. An objective of the presently claimed invention is to provide an optical compensating film that has durability and can be formed by coating an acrylic adhesive, which is a transparent adhesive used suitably for an optical film, directly onto a norbornene-based resin film. An advantage of this durability is that it is possible to prevent the occurrence of a foaming phenomenon or peeling at an interface surface of an adhesive, as explained in the present specification, for example on page 1, lines 30-36.

On the contrary, Examples 14 and 15 of Matsui US'439 disclose an adhesive layer provided directly on a norbornene-based resin film, but the adhesive layer of Matsui US'439 is formed of an elastic epoxy-silicon-based adhesive. Thus, Matsui US'439 does not provide any motivation to increase adhesion between an acrylic adhesive and a norbornene-based resin film. On the contrary, Matsui US'439 suggests using a different adhesive.

Furthermore, Matsui JP'211 provides a primer layer between an adhesive layer and a norbornene-based resin film. Thus, Matsui JP'211 does not provide any motivation to increase the adhesive strength between a norbornene-based resin film and an adhesive layer that is provided directly thereon. On the contrary, Matsui JP'211 suggests using a primer.

In summary, a person of ordinary skill in the art would not have found any suggestion or motivation to modify Takahashi to increase an adhesive strength of its adhesive with respect to a norbornene-based resin film, because the cited references fail to identify either insufficiency of adhesion or optical advantages of controlling adhesive strength. In other words, the cited references do not raise an incentive to modify the construction of Takahashi.

In particular, the person of ordinary skill in the art would not have been motivated to refer to any of Matsui US'439 and Matsui JP'211 to modify Takahashi, because that person would not have found any guidance in either Matsui US'439 or Matsui JP'211 regarding any expected advantages or feasibility of modifying the adhesive characteristics of an acrylic adhesive disposed directly on a norbornene-based resin film. Thus, even if, *arguendo*, that person had attempted to combine the cited references, this would have resulted in using the non-acrylic adhesive of Matsui US'439 and/or the primer of Matsui JP'211, not in an interest in modifying the adhesive characteristics of an acrylic adhesive disposed directly on a norbornene-based resin film.

In contrast, the presently claimed invention provides an optical compensating film comprising an adhesive layer having adhesive property on both sides and formed by coating the adhesive onto a stretched norbornene-based resin film, wherein (i) the adhesive strength between the adhesive layer and the stretched norbornene-based resin film is not smaller than 10 N/20 mm while (ii) the adhesive is an acrylic adhesive and the adhesive layer is disposed directly on the norbornene-based resin film. These features of the presently claimed invention are not taught or suggested in any of Takahashi and the Matsui references, and Konishi fails to remedy these deficiencies of Takahashi and Matsui. Therefore, the present claims are not obvious over the cited references taken alone or in any combination.

In addition, with respect to the dependent claims, it is submitted that the cited references fail to teach or suggest the combinations of features as recited in these respective claims. Therefore, the dependent claims are not obvious over the cited combinations of references.

In view of the above, it is submitted that the rejections should be withdrawn.

In conclusion, the invention as presently claimed is patentable. It is believed that the claims are in allowable condition and a notice to that effect is earnestly requested.

In the event there is, in the Examiner's opinion, any outstanding issue and such issue may be resolved by means of a telephone interview, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number listed below.


Serial Number: 10/006,790

Group Art Unit: 2871

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of the response period. Please charge the fee for such extension and any other fees which may be required to our Deposit Account No. 50-2866.

Respectfully submitted,

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